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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,616	09/27/2000	Masakazu Nishikawa	Q58116	6123

7590

06/28/2002

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2100 Pennsylvania Avenue N W
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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 06/28/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/670,616

Examin r

Kevin M Bernatz

Applicant(s)

NISHIKAWA ET AL.

Art Unit

1773

-- The MAILING DATE of this c mmunicati n appears n th c ver sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-10,12-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-10,12-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 2 - 20, filed on April 10, 2002, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1, 9 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Okuyama et al. ('607).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on October 22, 2001 (Paper No. 3).

Claim Rejections - 35 USC § 103

4. Claims 2, 4 – 6, 8, 10, 12 – 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama et al. as applied above, and further in view of Hosoi et al. ('794).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on October 22, 2001 (Paper No. 3).

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5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama et al. in view of Hosoi et al. as applied above, and further in view of Okudaira et al. ('853) and Maro et al. ('801).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on October 22, 2001 (Paper No. 3).

Examiner's Comments

6. The examiner notes applicants' Table 1, which contains evidence suggesting an improvement over the prior art when using a specific combination of primer and seed layer. Since polymeric "floppy" substrates are old in the art and primer and seed layers are also old in the art (as exemplified by Okuyama et al.), patentability *may* reside in a showing of unexpected improvement when a certain combination of these layers are used. Should applicants' desire to pursue patentability by a showing of *unexpected* results, the examiner reminds applicants' that the claims must be commensurate with the showing of unexpected results (i.e. current examples only use a polyimide substrate with a polyimide flattening layer) and that embodiment(s) *representative* of a species must be shown in order to claim a species. Furthermore, the examiner notes that Maro et al. ('801) appears to teach that the results would not be unexpected when placing a select metallic seed layer above a resin substrate to prevent cracking (col. 4, lines 36 – 48: "a layer composed of at least one material selected from the group consisting of Ti, Ta, Mo, V, Zr, Nb and their alloys is formed between a resin substrate and an underlayer as a lowest layer ... thereby preventing crazings caused by the underlayer").

Response to Arguments

7. The rejection of claims 1 - 20 under 35 U.S.C § 102/103 – Okuyama et al., either alone or in combination with various references

Applicant(s) argue(s) that Okuyama et al. is directed to a rigid disk and that the term “floppy” in the claims carries additional limitations than just “any non-glass, ceramic, silicon or carbon substrate”. The examiner respectfully disagrees.

While Okuyama et al. does disclose embodiments representing known hard disk substrates, the examiner notes that “plastics” are also known floppy disk substrates (see U.S. Patent No. 5,277,977, col. 10, lines 49 – 58: “Flexible *plastic* films used in ... floppy disks may be employed as well as rigid substrates such as aluminum alloy and glass” [emphasis added]). As such, Okuyama et al. is deemed to read on applicants’ current claims since the current claims contain no mechanical properties to distinguish what applicants intend to claim as “floppy”.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
June 23, 2002



STEVAN A. RESAN
PRIMARY EXAMINER